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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,119	09/18/2002	Anthony Ellis	001-040	8216
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JEFFREY FURR 253 N. MAIN STREET JOHNSTOWN, OH 43031			EXAMINER LAFORGIA, CHRISTIAN A	
			ART UNIT 2131	PAPER NUMBER
DATE MAILED: 03/07/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/065,119	<b>Applicant(s)</b> ELLIS, ANTHONY	
	<b>Examiner</b> Christian La Forgia	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 04 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 November 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-24 have been presented for examination.

#### ***Drawings***

2. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because the labels of the drawings are tiny and difficult to read, and therefore difficult to ascertain the Applicant's invention from the drawings. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

#### ***Information Disclosure Statement***

3. The listing of references on pages 2-4 of the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

#### ***Specification***

4. The use of the trademarks Microsoft Internet Explorer, Netscape Navigator, and Opera has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

5. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

***Claim Objections***

6. Claim 23 is objected to because of the following informalities: The claim language reads “to send instant messages users instantly.” For the examination proceedings the Examiner will interpret the claim limitation as “to send instant messages to users instantly.” Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. As per claim 24, citing claim limitations as a computer function representing a computer listing *per se* (based on paragraphs 60 and 61 from the Specification), that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical “thing” nor a statutory process, as there are not “acts” being performed. Such claimed computer functions do not define any structural and functional interrelationships between the computer function and other claimed aspects of the invention which permit the computer function’s functionality to be realized. Since a computer function is merely a set of instructions capable of being executed by a computer, the function itself is not a process, without the computer-readable medium needed to realize the computer function’s functionality. In contrast, a claimed computer-readable medium encoded with a computer function defines structural and functional interrelationships between the computer

function and the medium which permit the computer function's functionality to be realized, and is thus statutory. **Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: securing encryption and secure distribution of a file or digital information using a download generating script; installing a monitoring component at user end; and having monitoring component checks file access rights through a communication means and having monitoring component control access to file or digital information based on password rights received from a server. Claim 24 sets forth a method, but fails to disclose any method steps.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 6, 7, and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,920,567 to Doherty et al., hereinafter Doherty, in view of U.S. Patent Application Publication No. 2001/0034712 to Colvin, hereinafter Colvin.

13. As per claim 1, Doherty teaches a method of controlling usage and distribution of electronic information comprising:

securing encryption and secure distribution of a file or digital information using a download generating script (column 5, line 47 to column 6, line 6, column 7, lines 3-23, column 8, lines 37-59, i.e. constructing a digital content file to be distributed and installed by a user system);

installing a monitoring component at user end (Figure 1a [block 16], column 4, line 63 to column 5, line 3, column 5, line 47 to column 6, line 15, column 8, lines 1-6, i.e. installing license monitor and control mechanism that is associated with the file access control mechanism); and

having monitoring component checks file access rights through a communication means and having monitoring component control access to file or digital information (column 8, lines 7-36, column 9, lines 6-23, i.e. the access control mechanism executes the requirements to obtain license information defining a license allowing use of the digital contents, generates license information defining a license for use of the digital content in the user system and provides the license information defining a license for use of the digital content in the user system to the user system).

14. Doherty does not disclose wherein the file access rights are checked at time intervals or where the control access is based on password rights received from a server.

15. Colvin teaches wherein the file access rights are checked at time intervals or where the control access is based on password rights received from a server (paragraphs [0047], [0048], [0050], [0053], i.e. authorization intervals, and password transferred to user/software).

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16. It would have been obvious to one of ordinary skill in the art at the time the invention was made to check the file access rights at regular intervals and control access based on password rights received from the server, since Colvin states at paragraph [0053] that a password may be used to disable the content if an unauthorized user is detected, thereby acting as a deterrent to piracy.

17. Regarding claim 2, Doherty does not disclose wherein access and usage rights to the file can be changed or revoked.

18. Colvin teaches wherein access and usage rights to the file can be changed or revoked (paragraph [0053]).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to change or revoke the access rights, since Colvin states at paragraph [0053] that a password may be used to disable the content if an unauthorized user is detected, thereby acting as a deterrent to piracy.

20. Regarding claims 6 and 7, Doherty does not teach said monitoring component checks file password rights at time intervals through a communication means to a remote server when the file is accessed.

21. Colvin teaches said monitoring component checks file password rights at time intervals through a communication means to a remote server when the file is accessed (paragraphs [0047], [0048], [0050], [0053], i.e. authorization intervals, and password transferred to user/software).

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22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to check the file access rights at regular intervals and control access based on password rights received from the server, since Colvin states at paragraph [0053] that a password may be used to disable the content if an unauthorized user is detected, thereby acting as a deterrent to piracy.

23. Regarding claims 10-12, Doherty does not disclose the steps of having an auto-generation of password for file access and having said password being used by the access monitor to control the access rights to the file.

24. Colvin teaches the steps of having an auto-generation of password for file access and having said password being used by the access monitor to control the access rights to the file (paragraphs [0047], [0048], [0050], [0053]).

25. It would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically generate password files for access rights, since Colvin states at paragraph [0053] that a password may be used to disable the content if an unauthorized user is detected, thereby acting as a deterrent to piracy.

26. Regarding claim 13, Doherty teaches the step of distributing the file manually (column 8, lines 37-59)

27. Regarding claims 14 and 15, Doherty teaches the step of distributing the file automatically using API integration (column 8, lines 37-59).



28. Regarding claim 16, Doherty teaches an administrator function (column 34, lines 44-59).
29. Regarding claim 17, Doherty teaches the steps of allowing the End User to move the file from one computing device to another (column 38, lines 3-7).
30. Regarding claim 18, Dougherty teaches the steps of allowing the End User to move the file from one computing device to another by un-registering the file and re-registering the file (column 38, lines 3-67).
31. Regarding claims 19 and 20, Doherty teaches the steps of having an access control database on a computing device with data for each file user (column 10, lines 9-23).
32. Regarding claims 21 and 21, Doherty teaches the steps of having user management database on a computing device with data for each file user (column 8, lines 37-59).
33. Regarding claim 23, Doherty does not disclose the steps of having the ability to send instant messages users instantly via the monitoring component.
34. Colvin teaches the steps of having the ability to send instant messages users instantly via the monitoring component (Figures 11 [blocks 442, 450], 12 [blocks 479, 484, 494, 502], paragraphs [0083], [0088]).

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35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the ability to send instant messages to users, since Colvin discloses at paragraphs [0083] and [0088] that providing messaging allows the system to inform the user of errors entering their keying information, thereby preventing them from accessing the content.

36. Claims 3-5 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doherty in view of Colvin as applied to claim 1 above, and further in view of U.S. Patent Application No. 2002/0166056 to Johnson et al., hereinafter Johnson.

37. Regarding claims 3-5, Doherty and Colvin do not disclose said securing encryption is done by a File Owner on File Owner's computing device and then uploaded to a server using a communication means.

38. Johnson teaches said securing encryption is done by a File Owner on File Owner's computing device and then uploaded to a server using a communication means (Figure 2 [blocks 242, 246, 248], paragraphs [0053], [0057]-[0058]).

39. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the file owner encrypt the content and upload it to a server, since Johnson states at paragraph [0005] that it would provide a way to secure digital content that could not be easily defeated, yet not impede the end-user's ability to use the content, while ensuring that the file owner is duly compensated for the use of their content.

40. As per claim 24, Doherty teaches a method of controlling usage and distribution of electronic information, comprising:

having an FS Encryption Utility function (column 5, line 47 to column 6, line 6, column 7, lines 3-23, column 8, lines 37-59),

having an FS Rights Enforcement Monitor function (Figure 1a [block 16], column 4, line 63 to column 5, line 3, column 5, line 47 to column 6, line 15),

having a Database Management Server (column 8, lines 37-59),

having a Access Management Server (column 10, lines 9-23),

having a File Distribution Server (Figure 2 [block 28], column 12, lines 25-47), and

41. Doherty does not disclose having a File Secure File Owner Server (),having a Message Monitoring System.

42. Johnson discloses having a File Secure File Owner Server (Figure 2 [blocks 242, 246, 248], paragraphs [0053], [0057]-[0058]).

43. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the file owner encrypt the content and upload it to a server, since Johnson states at paragraph [0005] that it would provide a way to secure digital content that could not be easily defeated, yet not impede the end-user's ability to use the content, while ensuring that the file owner is duly compensated for the use of their content.

44. Colvin discloses having a Message Monitoring System (Figures 11 [blocks 442, 450], 12 [blocks 479, 484, 494, 502], paragraphs [0083], [0088]).

45. It would have been obvious to one of ordinary sill in the art at the time the invention was made to have the ability to send instant messages to users, since Colvin discloses at paragraphs [0083] and [0088] that providing messaging allows the system to inform the user of errors entering their keying information, thereby preventing them from accessing the content.

46. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doherty in view of Colvin as applied to claim 1 above, and further in view of U.S. Patent Application Publication No. 2003/0187801 to Chase, Jr. et al., hereinafter Chase.

47. Regarding claims 8 and 9, Doherty and Colvin do not disclose allowing a File Owner to change access and usage rights to a given file or a given End User.

48. Chase teaches allowing a File Owner to change access and usage rights to a given file (paragraph [0146]) or a given End User (paragraph [0010], [0319]).

49. It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the file owner to change the privileges associated with the file and user, since Chase states at paragraphs [0007]-[0010] that such a modification would allow a file owner to disable a file if it is found out that the file has been distributed without permission.

### ***Claim Objections***

50. Claim 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 6 recites the limitation said monitoring component checks file password rights at time intervals through a communication means to a remote server, which is covered by the last limitation of claim 1.

### ***Conclusion***

51. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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52. The following patents are cited to further show the state of the art with respect to digital rights management, such as:


United States Patent No. 6,389,538 to Gruse et al., which is cited to show a system for tracking end-user content usage.

53. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian La Forgia whose telephone number is (571) 272-3792. The examiner can normally be reached on Monday thru Thursday 7-5.

54. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

55. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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